

## REMARKS

### **A. Status of the Claims**

Claims 34-45 are pending in the case and on appeal. Claims 34-41 are amended herein. Claims 42-45 are canceled herein. New claims 46-61 are added. Therefore, claims 34-41 and 46-61 are pending after entry of this Amendment and currently under consideration.

### **B. The New Ground of Rejection under 35 U.S.C. § 101 Set Forth in the Decision on Appeal is Overcome**

In the Decision on Appeal dated June 4, 2009, the Board affirmed the previous obviousness rejections to claims 42-45; reversed the obviousness rejections to claims 34-41; and entered a new ground of rejection to claims 34-45 as being directed to non-statutory subject matter under 35 U.S.C. § 101.

Applicants have canceled claims 42-45 in the Amendment contained herein; therefore, the rejection under 35 U.S.C. § 101 as to these claims is moot.

Amended claims 34-41 overcome the rejection under 35 U.S.C. § 101. The § 101 rejections were based on the machine-or-transformation test of *In re Bilski*, which provides: “[A]n applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.” 545 F.3d 943, 961. As amended, claims 34 and 38 now recite “[a]n electronic inflation-adjusted financial instrument stored in a data storage device.” The data storage device cited is a particular machine specially configured to hold account information for depositors and borrowers. Therefore, Applicants assert that the rejection under 35 U.S.C. § 101 is overcome by the present amendments. *See e.g., Ex Parte Wasynczuk*, 87 U.S.P.Q.2d 1826 (B.P.A.I. June 2, 2008) (holding that two physical computing devices recited in the body of a process claim for simulating operation of a physical system were “particular machines” sufficient to satisfy § 101);

and *Ex Parte Borenstein*, Appeal No. 2008-3475, slip op. at 2, 10 (B.P.A.I. Mar. 30, 2009) (holding that a computer or database that was inherent (*i.e.*, not even expressly recited) in an e-commerce process claim was sufficient to satisfy the “machine” prong for patentability).

Support for these amendments can be found in at least the following lines of the Specification and Figures. In one example, “[d]epositor characteristics are listed on a Deposit Funds Available Data File 16 (“DFADF”), wherein characteristics listed include a depositor identifier, the amount of funds available, the term of the account, the duration of the account, the type of account and the account retirement schedule.” Specification at p. 10, ll. 1-6. In another example, “[c]haracteristics of borrowers 18 are similarly listed in a Loan Funds Desired Data File 20 (“LFDDF”), which includes the amount of the funds sought to be borrowed, the term of years for which the funds are desired, the duration of the loan account, the type of loan account and the loan account retirement schedule.” Specification at 10, ll. 20-25. Both the DFADF and the LFDDF comprise the “Account Management Dataprocessor” and are “parallel databases” “representing supply funds and demand funds, respectively.” Fig. 1; and Specification at p. 20, ll. 1-2. Notably, both the DFADF and LFDDF are entirely separate, tangible, and physical machines distinguishable from the Deposit Accounts and Loan Accounts for which they store information. *See* Fig. 1. In another example, Deposit Accounts and Loan Accounts are matched by matching parameters “stored” in the DFADF and LFDDF to create a “Hierarchical Matching File.” Specification at p. 20, ll. 4-6. Therefore each of amended claims are supported by the specification and figures, and comply with the written description requirement of 35 U.S.C. § 112.

By citing such a specially data storage device, amended claims 34-41 are patentable under 35 U.S.C. § 101 because the claims as amended satisfy the machine prong of the machine-

or-transformation test. Moreover, these claims include the limitations already found to be non-obvious under 35 U.S.C. § 103 by the Board. Therefore, Applicants request prompt allowance of the present claims.

New claims 46-61 are also proper subject matter under *Bilski*. Claims 46-61 recite a particular dataprocessor for computing the principal and accrual components. Ample support for this dataprocessor can be found in at least the following examples of the original claims, specification, and drawings. For example, original claims 13-15, which were canceled in the Preliminary Amendment, recite means for computing the accrual components and inflation rate comprising “means for data processing.” Claims 13-15. In another instance, the specification describes a flow chart “adaptable to data processing.” Specification at 12, ll. 7-12; *see also* Fig. 2. One embodiment designates the main data processing component as the “account management dataprocessor,” which includes a parallel database for data storage, data generation, and graphical displays. Specification at p. 9, ll. 12-22; p. 10, ll. 33-35; p. 14, ll. 5-9; p. 23, ll. 17-25. Another example states: “Such data-processing services the inflation-adjusting accounts in a number of ways, including the determination of their cash flow characteristics in changing inflationary environments and determining the anticipated effects of inflation on the account balance.” Specification at 9, ll. 19-22. And yet another example cites several drawing items that disclose data processing means specifically adapted to “compute” the principal retirement, inflation rate, accrual repayment, and amortization rate. Fig. 1-4. Therefore each of the new and amended claims are supported by the specification and figures, and comply with the written description requirement of 35 U.S.C. § 112.

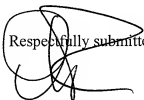
By claiming such a particularized data processing machine, the new claims 46-61 are also patentable under 35 U.S.C. § 101 because the claims as amended satisfy the machine prong of

the machine-or-transformation test. Moreover, these claims include the limitations already found to be non-obvious under 35 U.S.C. § 103 by the Board. Therefore, Applicants request prompt allowance of the present claims.

**C. Conclusion**

In view of the foregoing, Applicants respectfully submit that each of the pending and new claims are in condition for allowance. The Examiner is invited to contact the undersigned attorney at (512) 536-3055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David L. Parker', is written over the text 'Respectfully submitted,'.

David L. Parker  
Reg. No. 32,165  
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
Direct: (512) 536-3085  
Fax: (512) 536-4598

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